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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,125	05/22/2001	Elizabeth S. Light	112/002/CON1	9583

23874 7590 11/20/2002

VENTANA MEDICAL SYSTEMS, INC.
1910 INNOVATION PARK DRIVE
TUCSON, AZ 85737

EXAMINER

CHAKRABARTI, ARUN K

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 11/20/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/863,125

Applicant(s)
Light

Examiner
First Last

Art Unit
1234



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 16, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☒ Other: **Detailed Action**

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DETAILED ACTION

Specification

1. Claims 25-26 have been canceled without prejudice towards further prosecution. New claims 27-30 have been added.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 27-30 are rejected under 35 U.S.C. 103(a) over Lizard et al. (Histochemistry, (1994), Vol. 101, pages 303-310) in view of Bargmann et al. (U.S. Patent 4,935,341) (June 19, 1990)..

Lizard et al teach a method of visually detecting a single copy of the gene in chromosomal DNA in an intact cell using brightfield microscopy (Abstract), comprising:

heating the tissue or cell sample sufficiently to dissociate the native chromosomal target strands of DNA (Materials and Methods Section, Page 304, Column 2):

contacting the tissue or cell sample with a detectably-labeled nucleic acid probe under conditions that allow the rehybridization of the labeled nucleic acid to form a target-probe duplex (Materials and Methods Section);

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contacting the target-probe duplex with an anti-label antibody under conditions allowing the antibody to bind to the label (Materials and Methods Section);

contacting the anti-label antibody with an enzyme and a chromogen composition under conditions allowing the development of a visually detectable chromogen substrate signal at each target-probe duplex separate and distinct from the chromogenic signals of other copies of the chromosomal target nucleic acid sequence (Materials and Methods Section); and

detecting the chromogenic substrate signal using brightfield microscope conditions (Abstract, Materials and Methods Section, Microscopic examination Subsection, and Figures 1-4).

Lizard et al teach a method, wherein the detectably-labeled nucleic acid probe is labeled with a moiety selected from biotin (Abstract and Materials and Methods Section).

Lizard et al teach a method, wherein the enzyme is selected from phosphatase and a peroxidase (Materials and Methods Section, FISH, EISH, and detection of DNA-DNA hybrids Subsection).

Lizard et al teach a method, wherein the chromogen is selected from NBT/BCIP (Materials and Methods Section, FISH, EISH, and detection of DNA-DNA hybrids Subsection).

Lizard et al do not teach the method, wherein the Her-2/neu gene is detected by its specific corresponding probe.

Bargmann et al. teach the method, wherein the Her-2/neu gene is detected by its specific corresponding probe. (Abstract and Column 2, line 1 to Column 5, line 20).

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It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to combine and substitute the method, wherein the Her-2/neu gene is detected by its specific corresponding probe. of Bargmann et al. in the detection of nucleic acids in cells by chromogenic method of Lizard et al. since Bargmann et al. state, " The approach described above has been used successfully in identifying the point mutation which causes activation of the neu protooncogene in DNA from a chemically induced rat neuroblastoma. It has also been used to verify the occurrence of the same activating point mutations, suspected to be present in, in seven other neu oncogenes. The approach described can be used, with modification, in identifying point mutations which cause activation of human neu oncogenes (Column 4, lines 13-23)". By using these strong motivations as well as scientific reasoning, one ordinary practitioner would have combined and substituted the method, wherein the Her-2/neu gene is detected by its specific corresponding probe. of Bargmann et al. in the detection of nucleic acids in cells by chromogenic method of Lizard et al. to improve the detection and localization of specific oncogene nucleic acid sequences within morphologically intact cells. An ordinary practitioner would have been motivated to combine and substitute the method, wherein the Her-2/neu gene is detected by its specific corresponding probe. of Bargmann et al. in the detection of nucleic acids in cells by chromogenic method of Lizard et al.. in order to achieve the express advantage, as noted by Bargmann et al, of the method which provides the approach that can be used successfully in identifying the point mutation which causes activation of the neu protooncogene in DNA from a chemically induced rat neuroblastoma and which also can be used

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to verify the occurrence of the same activating point mutations, suspected to be present in seven other neu oncogenes and which further can be used, with modification, in identifying point mutations which cause activation of human neu oncogenes.

Response to Amendment

4. In response to amendment, 112(second paragraph), 102(b) and 103(a) rejections are hereby withdrawn. However, new 103(a) rejections have been included.

Response to Arguments

5. Applicant's arguments with respect to all pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D. whose telephone number is (703) 306-5818.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703)308-1152.

Any inquiry of general nature or relating to the status of this application should be directed to the Group analyst Chantae Dessau whose telephone number is (703)605-1237.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission via the P.T.O. fax Center located in Crystal Mall 1. The CM1 Fax Center numbers for Technology Center 1600 are either (703) 305-3014 or (703) 308-4242. Please note that the faxing of such papers must conform with the Notice to comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Arun Chakrabarti,
Patent Examiner
Art Unit 1634

November 14, 2002


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600